

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 13-36 are pending after entry of the amendments set forth herein.

Claims 12-36 were examined. Claims 12-36 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Office Action

In the Official Action of October 13, 2005, claims 12-36 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-18 of U.S. Patent No. 6,199,566. The Examiner interpreted all elements of claim 12 to be found in claims 8-18 of U.S. Patent No. 6, 199,566, and therefore considered claim 12 to be anticipated by claim 8 of U.S. Patent No. 6, 199,566, as being a species of the genus recited by claim 12.

Initially, Applicants note that claim 12 was canceled in the Preliminary Amendment filed on February 15, 2004 in the instant application. Accordingly, it is respectfully submitted that the present ground of rejection is moot with regard to claim 12, as claim 12 is not currently pending. As to claim 13, Applicants do not agree that claim 8 recites all of the features of the present claim 13, since claim 8 of the patent does not recite a main body configured to rest against the frontal body of a patient.

Further, with regard to claims 14-16, the patent claims do not specifically recite the claimed contact points and spatial relationship of the lifting arm to such contact points. Nor do any of the patent claims cited by the Examiner recite a hinged retractor arm as recited in claim 18 of the present application. Nor are first and second driving mechanisms recited in the patent claims 8-18, with regard to claim 19 of the present application. With regard to claims 20 and 21, the patent claims 8-18 do not recite a driving mechanism as claimed. With regard to claim 22, the patent claims do not recite a rotatably mounted retractor arm. With regard to claim 23, the patent claims do not recite a hinged retractor arm. With regard to claims 27 and 33, the patent claims do not recite an organ positioner. With regard to claims 28 and 34, the patent claims do not recite a tissue positioner. With regard to claims 29-30 and 35, the patent claims do not recite a light mounted to the apparatus. With regard to claim 31, the patent claims do not recite a lifting arm configured to engage and lift at least a portion of

the lower ribs.

For at least the above reasons, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13-36 (claim 12 having been canceled) under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-18 of U.S. Patent No. 6,199,566, as being inappropriate.

Claims 12-36 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,736,774. The Examiner's statement that "the invention of claim 8 of the patent is in effect a "species" of the "generic" invention of claims 1-5" is not understood in this context. Clarification is requested.

The Examiner concluded that claim 12 is not patentably distinct from claims 1-5 of U.S. Patent No. 6,736,774. Again, Applicants note that claim 12 was canceled in the Preliminary Amendment filed on February 15, 2004 in the instant application. Accordingly, it is respectfully submitted that the present ground of rejection is moot with regard to claim 12, as claim 12 is not currently pending. As to claim 13, Applicants do not agree that claims 1-5 recite all of the features of the present claim 13, since claims 1-5 do not recite a main body configured to rest against the frontal body of a patient.

Further, with regard to claims 14-16, the patent claims do not specifically recite the spatial relationship of the lifting arm to the claimed contact points. Nor do any of the patent claims cited by the Examiner recite a hinged retractor arm as recited in claim 18 of the present application. Nor are first and second driving mechanisms recited in the patent claims 1-5, with regard to claim 19 of the present application. With regard to claims 20 and 21, the patent claims 1-5 do not recite a driving mechanism as claimed. With regard to claim 22, the patent claims do not recite a rotatably mounted retractor arm. With regard to claim 23, the patent claims do not recite a hinged retractor arm. With regard to claims 27 and 33, the patent claims do not recite an organ positioner. With regard to claims 28 and 34, the patent claims do not recite a tissue positioner. With regard to claims 29-30 and 35, the patent claims do not recite a light mounted to the apparatus. With regard to claim 31, the patent claims do not recite a lifting arm configured to engage and lift at least a portion of the lower ribs.

For at least the above reasons, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13-36 (claim 12 having been canceled) under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Patent No. 6,736,774, as being inappropriate.

Claims 12-36 were rejected under 35 U.S.C. Section 102(e), as being anticipated by Nicholas et al., U.S. Patent No. 5,967,974. With respect to claims 12 and 31, the Examiner asserted that Nicholas et

al. discloses a surgical apparatus for accessing a beating heart, the apparatus comprising a main body (110) configured to rest against the frontal body of a patient; and a lifting arm (126) movably mounted to the main body and adapted to engage and lift at least a portion of the ribs of the patient, relative to the remainder of the patients body below the rib cage, when the patient is positioned horizontally.

Applicants respectfully disagree that Nicholas et al. anticipates claims 13 and 31 (claim 12 having been canceled). Nicholas et al. discloses a surgical retractor that is configured to create an opening between an adjacent pair of ribs. As noted at column 4, lines 61-65, in the case of heart surgery, the retractor hooks 132 and 112 are inserted between the fourth and fifth ribs so that hook portion 132 biases against a first of these ribs and hook portion 112 biases against a second of these ribs in opposite directions. In this position, the retractor frame 112 (sic, 110) is substantially parallel to the ribs. Adjustment knob 128 is then turned to retract hook portion 132 away from hook portion 112 until the desired opening is achieved between the adjacent ribs. Applicants note that at this stage of the procedure, neither rib is lifted, as they are just laterally separated. Next, the outwardly extending portion 118 of frame 110 is elevated by raising end 118 so as to elevate one side of the retractor.

Thus, the main body or frame 110 of Nicholas et al. is not configured to rest against the frontal body of the patient while a lifting arm is moved to lift a portion of the ribs of the patient. To the contrary, the main body or frame 110 of Nicholas et al. must be lifted to carry out the lifting of a rib. To further clarify this distinction, Applicants have amended claims 13 above to note that the main body remains in its resting position against the frontal body of the patient while the at least a portion of the ribs are lifted. Claim 31 has been similarly amended to note that the retractor remains in the resting position while the lifting arm lifts.

Further, it is noted that the device of Nicholas et al. is not adapted to access a beating heart via a xyphoid incision, as the hook member 112 would cause significant damage to the soft tissues in the abdominal region if this device were used in a xyphoid incision.

With regard to claims 17 and 36, Nicholas et al. fails to disclose a retractor arm as recited. Applicants have not found a disclosure of a retractor arm in column 4, lines 15-67, column 5, lines 1-67 or column 6, lines 1-24 of Nicholas et al., as specifically referenced by the Examiner. If the Examiner maintains this position, the Examiner is requested to specifically identify what portion of the device 100 that the Examiner interprets to be a retractor arm. Since Nicholas et al. does not disclose a retractor arm, it follows that Nicholas et al. also fails to disclose a retractor arm that comprises a hinge (claims 18 and 23) or a retractor arm that is rotatably mounted to said body (claim 22).

With regard to claims 19 and 21, Nicholas et al. fails to disclose a first driving mechanism for

driving said lifting arm with respect to said body to perform said lifting. The Examiner interpreted the lifting arm of Nicholas et al. to be the hook member 126. However, as noted above, movement of the hook member does not perform lifting, but merely spreads one rib apart from another. The lifting is performed by raising the main body itself (portion 118), and thus Nicholas et al. does not disclose a first driving mechanism as recited in claim 19. Nor does Nicholas et al. disclose a second driving mechanism for driving a retractor arm, since Nicholas et al. does not disclose a retractor arm, as noted above. Similarly, with regard to claim 20, Nicholas et al. does not disclose a driving mechanism for driving said lifting arm and said retractor arm, since Nicholas et al. does not disclose a retractor arm.

With regard to claim 22, Nicholas et al. does not disclose any component that is rotatably mounted to the main body of the device, and does not disclose a retractor arm whatsoever. With regard to claim 23, Nicholas et al. does not disclose a retractor arm mounted to a main body via a hinge.

With regard to claims 24 and 25, Nicholas et al. does not disclose a beating heart stabilizer mounted on the body of the apparatus 100. With regard to claims 26 and 32, Nicholas et al. does not disclose a beating heart stabilizer mounted on a retractor or a retractor arm, since Nicholas et al. discloses neither a beating heart stabilizer nor a retractor arm.

With regard to claims 27-28 and 33-34, Nicholas et al. does not disclose an organ positioner or a tissue positioner fixed to the body of apparatus 100 or to a retractor.

With regard to claims 28, 29 and 36, the Examiner indicated that the use of fiber optic lighting in the retractor field is old and well known in the art as best seen in the cited pertinent art. However, Nicholas et al. does not disclose this feature and, as such, the Examiner's remarks are an improper basis for an anticipatory type rejection made under 35 U.S.C. Section 102.

In view of the above amendments and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13-36 under 35 U.S.C. Section 102(e), as being anticipated by Nicholas et al., U.S. Patent No. 5,967,974, as being clearly inappropriate.

Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-008CON2.

Respectfully submitted,

LAW OFFICE OF ALAN W. CANNON

Date: _____

1/13/06

By: _____



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